



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

10

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,999	01/16/2002	Holger Klapproth	STURK 0002	6124
24203	7590	05/27/2004	EXAMINER	
GRIFFIN & SZIPL, PC SUITE PH-1 2300 NINTH STREET, SOUTH ARLINGTON, VA 22204			CEPERLEY, MARY	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

05252004

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

See the attached letter.

Mary (Molly) E. Ceperley
Primary Examiner
Art Unit: 1641

Art Unit: 1641

1) The reply filed on March 03, 2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): see the paragraphs directly below. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

2) Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

37 CFR 1.111(b) {MPEP 714.02} states that:

The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

37 CFR 1.111© {MPEP 714.02} states that:

In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

3) The following paragraphs detail examples of why the March 2004 Remarks are unresponsive and do not specifically point out the distinctions between the claimed and prior art compounds.

Art Unit: 1641

a) The essence of the invention lies in the potential novelty/unobviousness of the compounds of formula (I) of claim 1. For this reason, applicant must establish the novelty/unobviousness of the compounds of formula (I). The patentability of claims directed to the use of these compounds and surfaces containing them will be based on the novelty/unobviousness of these compounds. See *In re Ochiai*, {71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995)} and *In re Brouwer* {77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996)}.

The examiner has pointed out specific compounds of the prior art which anticipate or render obvious the compounds of formula (I) of instant claim 1. Applicant's generic discussions of the prior art references fail to specifically address how the claimed compounds differ from the prior art compounds. For example, the examiner has rejected claim 1 over the Bertozzi et al reference specifically citing the compound of formula **3**. Applicant's sole response to this rejection is the statement that "Bertozzi teaches bifunctional polyethylene glycol derivatives. The Bertozzi reference fails to overcome the deficiencies in the references as discussed above." There is no discussion of the Bertozzi et al reference *per se* specifically pointing out how the compound of claim 1 is distinguishable from the compound of Bertozzi et al.

b) Similarly, applicant's statement in the second full paragraph of page 11 of the March 2004 response that "regarding the rejection of claim 5, none of the references employed against the claim...teach that Z is ..." does not specifically address how the claimed compounds differ from the applicable prior art compounds of each of the references which are expressly pointed out by the examiner. Although applicant has redefined the variable "Z" in claim 1, applicant has not attempted to establish on the record that the claimed compounds differ in fact from the compounds of the prior art.

c) Applicant's comments regarding the Genset reference (Remarks, page 13) do not address the novelty/unobviousness of the claimed compounds. The examiner has cited specific compounds in the Genset reference (first Office action, paragraph **10J**) but applicant's argument states only that the use of the prior art compounds may be different from the use of the compounds of the instant invention. There is no discussion presented regarding any structural differences between the compounds of claim 1 and

Art Unit: 1641

the prior art compounds. It is further noted that the term "linker system" of instant claim 1 is not a limitation on the claimed compounds per se.

d) The last paragraph of page 11 of the March 2004 response addresses the rejection of the conjugates of claims 11-14 over Becton but fails to address the novelty/unobviousness of the rejected compounds on which patentability must be based.

e) Applicant's comments regarding the Zalipsky reference (Remarks, page 12, first full paragraph) are directed to the case in which formula (I) of claim 1 contains $X = SiW_3$. However, Zalipsky et al was not applied for any discussion of this type of X group (see the first Office action, paragraph 7).

4) To further advance prosecution, if applicant believes that the patentability of the dependent claims is based on the specific parameters/variables alleged by the examiner to be routine modifications in the art (e.g. choice of well known solid phases) and the patentability of these claims is not based on the patentability of the compounds of formula (I) (March 2004 Remarks, paragraph bridging pages 10 and 11), applicant should make a statement to this effect on the record.

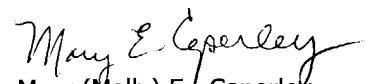
5) An inquiry of a general nature which is not related to the prosecution on the merits should be directed to Technology Center 1600 telephone number (571) 272-1600. The general fax number for the USPTO is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823.

Art Unit: 1641

May 25, 2004



Mary (Molly) E. Ceperley

Primary Examiner

Art Unit 1641